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REMARKS/ARGUMENTS

Claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48 and 50 stand rejected in the outstanding Official Action. Claims 18, 33 and 47 have been amended and therefore claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48 and 50 remain in the application.

In the Official Action at page 8, section 9, objection is taken with respect to claim 33. Applicant has amended the last line of claim 33 to change "said file" to read "said one of said files" as suggested by the Examiner.

In response to section 10 on page 8 of the Official Action, claim 47 has been amended to read as the Examiner interprets the claim, i.e., "a data storage medium on which is stored executable instructions which when executed by a processor performs the method of claim 41."

Any further objection to claims 33 and 47 is respectfully traversed.

Claims 18 and 19 stand rejected under 35 USC §112 (second paragraph) on page 8, section 11 of the outstanding Official Action. The Examiner objects to a lack of antecedent basis for "the at least one predefined issue." Applicant has deleted the word "the" thereby obviating any reference to a previously recited "at least one predefined issue." In view of the amendment to claim 18, it is submitted that there is no further basis for rejection of claim 18 under 35 USC §112 (second paragraph) and any further rejection of claim 18 or claim 19 dependent thereon is respectfully traversed.

Independent claims 1 and 33 and numerous claims dependent thereon stand rejected under 35 USC §103 as being unpatentable over Conklin ("gIBIS: A Hypertext Tool for Exploratory Policy Discussion") in view of Hirose (U.S. Patent 5,784,286) in view of Regli ("A Survey of Design Rationale Systems"). The Examiner's rejection based upon the Conklin,

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Hirose and Regli combination as expanded upon in the outstanding Final Rejection has numerous errors of law and fact as will be discussed below.

Error #1. The Examiner's contention that one of Conklin, Hirose and Regli teach the claim limitation "said directed link is bi-directional to permit a user to traverse the link in either direction" is simply incorrect

In section 13, page 9 of the Final Rejection, the obviousness rejection is now over a three-reference combination including Conklin, Hirose and Regli. While the Examiner has quoted Applicant's previously filed amendment arguments (bridging pages 3-5), the Examiner does not allege that Conklin or Regli teach the claimed "directed link is bi-directional to permit a user to traverse the link in either direction." The only response is on page 5, section 7, j, ii, in which the Examiner states that Hirose "appears" to support bi-directional links. As the Examiner will appreciate, the independent claim specifically defines "bi-directional" as permitting "a user to traverse the link in either direction." While the Examiner contends that Hirose "appears" to support bi-directional links, appearing to support is not the test of obviousness – the cited prior art reference must disclose the claimed element.

The Examiner is reminded that the Court of Appeals for the Federal Circuit has held that "the PTO has the burden under Section 103 to establish a *prima facie* case of obviousness." *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." None of the references teach the claimed "directed link." It is noted that the Examiner does not allege that Hirose discloses the claimed "directed link" as defined in the claim. In fact, none of

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Conklin, Hirose or Regli references is cited for teaching the claimed "directed link" which is "bi-directional to permit a user to traverse the link in either direction." The Examiner is again queried as to where he believes this claimed feature is disclosed in any prior art reference. As noted above in the Federal Circuit decision, the burden is on the Examiner to establish where this structure is disclosed in a prior art reference and thus far the Examiner has failed to meet this burden.

Absent a disclosure of the claimed "directed link" in at least one prior art reference, the rejection of the independent claims and claims dependent thereon clearly fails for lack of evidence amounting a *prima facie* case of obviousness.

On page 12, section s, the Examiner alleges that the Regli reference teaches a "hyperlink" and further alleges that an ordinary artisan would know that hyperlinks are bi-directional. This contention is respectfully traversed. Hyperlinks, as generally known in the context of web browsers, for example, are clearly uni-directional links. The Regli reference's use of the word "hyperlinks" connotes only a uni-directional link and does not disclose or even suggest Applicant's claimed bi-directionality of a "directed link" which is defined to "permit a user to traverse the link in either direction."

Again, because the Examiner only relies upon the Regli reference, the disclosure of the claimed "directional link" must be contained in the Regli reference. There is no such disclosure and thus the rejection thereunder is respectfully traversed.

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Error #2. The Examiner fails to provide any rationale for combining bits and pieces of the three cited references and then combining them in the manner of Applicant's independent claims

On page 12, subsections u, v, w, the Examiner alleges a motivation for combining portions of the various references. In its recent decision, the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (April 2007), held that "[t]o facilitate review [of the reasons for combining prior art], this analysis should be made explicit." *Id.* at 1396.

The Supreme Court in its *KSR* decision went on to say that it followed the Court of Appeals for the Federal Circuit's advice that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (the Supreme Court quoting from the Court of Appeals for the Federal Circuit in *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006)).

The recitation of benefits of the Hirose reference "cost effective, useful and inexpensive design process recorder" is perhaps alleged to be the "reason" why one would combine Hirose with Conklin. However, these benefits have nothing to do with the elements being chosen from Hirose and combined with specific elements of Conklin. There is no indication as to why one of ordinary skill in the art would ignore the other teachings in the Hirose and Conklin references. As a result, the Examiner's statement in section u is merely a conclusory statement reciting generic benefits, i.e., "cost effective," "useful" and "inexpensive." These conclusory statements do not amount to the required explicit "analysis" of the rationale for picking and choosing elements and interrelationships and subsequently combining elements from a plurality of references.

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In section v, the Examiner again makes a broad sweeping conclusory statement that "to use the art of Regli with the art of Conklin" which presumably includes anything disclosed in Regli and anything disclosed in Conklin, would "provide a great aid to designers" and therefore this is the purported motivation for combining elements. The Examiner simply fails to provide any reason to pick and choose the "directed link" which he alleges is disclosed in Regli with the other elements of the Conklin reference and the Hirose reference in the manner claimed.

Furthermore, the Examiner is suggesting that he is only obligated to provide a motivation for combining elements of Hirose with the Conklin patent and then a separate motivation for combining elements of Regli with the Conklin patent. In fact, the Examiner has to provide a rationale for choosing and picking the elements taken from all three references and then combining them in the manner of Applicant's claims. There has to be some reason why the elements taken from Regli would be combined with the elements taken from Hirose and then why these elements would be combined with the elements disclosed in Conklin. The Examiner has simply provided no explicit analysis by which a reviewing court can conclude that he has met his burden of establishing why the elements allegedly taught in the prior art would be combined in the manner of Applicant's claims.

It is Applicant's view that the Examiner has simply utilized hindsight reasoning in picking and choosing elements and then merely alleging that it would be obvious to combine them in the manner taught only by Applicant's independent claims. This is not the standard of obviousness.

Error #3. The Examiner does not cite any portion of the Kogan, Nguyen and Weinreich references, which he alleges contains "bi-

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directional hyperlinks,” as teaching the claimed “directed link” as defined in the claims

Again, while the Examiner alleges that three prior art references teach “bi-directional hyperlinks” (see page 7, section f, ii), the Examiner ignores the language of Applicant’s claim, i.e., “said directed link is bi-directional to permit a user to traverse the link in either direction.” It is noted that assuming there to be a disclosure of “bi-directional hyperlinks” in Kogan, Nguyen and Weinreich, there is no reason for one of ordinary skill in the art to believe that the Regli reference teaches any “bi-directional” link, whether a hyperlink or the claimed “directed link” in independent claims 1 and 33.

It is the structure recited in Applicant’s claims which must be disclosed in at least one prior art reference in a combination rejection under §103. The Examiner has not indicated how or where Kogan, Nguyen or Weinreich teach Applicant’s claimed “directed link” instead of the Examiner’s hyperlink. Instead, the Examiner suggests that Applicant’s claim language is similar to a hyperlink which is disclosed in Regli and that Regli’s hyperlink is similar to bi-directional hyperlinks taught in Kogan, Nguyen and Weinreich and therefore there must be some sort of disclosure in those references which somehow relates to Applicant’s claimed invention.

If the Examiner cannot point to where or how a prior art reference teaches a “directed link” which is “bi-directional to permit a user to traverse the link in either direction,” there is simply no disclosure of that claimed element. The Examiner is respectfully requested to either identify where this specifically claimed and defined element is disclosed in any prior art reference or abandon this argument.

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Error #4. The Examiner's use of the word "appears" evidences the misapplication of the standard of "obviousness"

Throughout the outstanding Official Action, the Examiner alleges that the prior art references appear to teach various claimed features. However, it should be appreciated that what the references appear to teach is not the standard of obviousness as set forth by the Court of Appeals for the Federal Circuit.

As noted above, the burden is on the Examiner to establish a *prima facie* case of obviousness and to do this, the Examiner must show that the prior art references actually teach the various claimed elements, not that they appear to teach elements. After the Examiner has identified where each of the claimed elements and claimed interrelationships amongst elements are clearly disclosed in each of the prior art references, then the Examiner is then obligated to provide an "explicit" analysis of a rationale for picking and choosing elements from the various references and combining them in the manner of Applicant's independent claims.

Here, the Examiner's consistent use of "appears to teach" is believed an admission that the cited references do not actually teach or disclose the elements recited in Applicant's independent claims. As noted above, the Examiner has clearly failed to provide any explicit analysis as to why or how he combines elements taken from the various references in the manner disclosed only by Applicant's independent claims. As noted above, there is simply no *prima facie* case of obviousness under 35 USC §103 as interpreted by any of the decisions of the Court of Appeals for the Federal Circuit.

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Entry of the Amendment under Rule 116

Entry of the above minor amendments to claims 18, 33 and 47 is respectfully requested in that these amendments will obviate claim objections and rejections raised for the first time in the outstanding Final Rejection. While Applicant does not believe these amendments need to be made in order to go forward on appeal, it is noted that Applicant has complied with the Examiner's identification of problematic language in these claims. As specifically noted above, these amendments do not change the scope of any of the claims and indeed the Examiner has indicated that he has interpreted the improper claim language in the manner intended by the Applicant and the above amendments merely clarify that the claim language should indeed be interpreted in the manner in which the Examiner has already considered the claim.

Thus, entry of the above amendment would not appear to raise any new issue requiring further consideration and/or search, would eliminate the issues with respect to claim objections and rejections, thereby simplifying the appeal if necessary. Accordingly, and in view of the above, entry of the above amendments is respectfully requested.

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48 and 50 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact Applicant's undersigned representative.

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Respectfully submitted,

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